

PATENT APPL. NO. 10/016,850
REQUEST FOR CONTINUED EXAMINATION AND SUBMISSION
PETITION FOR ONE MONTH'S EXTENSION OF TIME

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APR 18 2007

ARGUMENT

Appellants are in receipt of the Examiner's Answer mailed January 18, 2007 in this matter. In that paper the Examiner refused to enter the Declaration of Patrick Hughes, Ph.D. (the Hughes Declaration, filed pursuant to 37 CFR 1.132 on the same day as the Appeal Brief.

Accordingly, the Applicants are hereby filing a Request for Continued Examination (RCE) in order to permit the entry of this Declaration, filed herewith. Applicants understand that the filing of such a RCE will be treated as a request to withdraw the appeal.

Additionally, in accordance with MPEP § 706.07(h)(II) Applicants hereby incorporate by reference in their entirety the arguments made in the Appeal Brief filed October 13, 2006 in this matter.

In addition, Applicants respond to the Examiner's Answer as follows:

The Section entitled Response to Argument (which contains the Examiner's substantive comments concerning the arguments made in the Appeal Brief) is predicated largely upon the non-entry of the Hughes Declaration, which is now being filed herewith.

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The Examiner's Answer also alleges that Applicant allege criticality to the differences in function between the claimed composition and the prior art. Applicants have never used the term "critical", but merely have pointed out the mentioned differences in function as an indication of what the prior art would teach the person of ordinary skill in the art. Far from "lending no patentable weight", obviousness must be determined of the basis of the differences (including functional differences) between the prior art and the invention, in accordance with the Supreme Court's decision in *Graham v. John Deere & Co.*, 383 U.S. 1 (1966), which states that it is critical to "guard against slipping into use of hindsight . . . and to resist the temptation to read into the prior art the teachings of the invention in issue." *Id.* at 36 (emphasis added).

The test articulated by the Graham Court considers: 1) the scope and content of the prior art; 2) the level of ordinary skill in the prior art; and 3) the differences between the claimed invention (considered as a whole) and the prior art.

The cited prior art simply does not render the presently claimed conjugates obvious to the person of ordinary skill in the art, typically a person with a Ph.D. and some year's experience in medicinal chemistry. Such a person would recognize that the present compositions, by virtue of their structure, would not function effectively in the method disclosed by DeSantis and mentioned in the Examiner's Answer for the treatment of glaucoma, which is substantially a condition of the anterior segment of the eye. As stated in the Hughes declaration, the present compositions are substantially targeted

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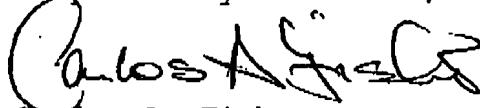
to the retinal epithelium, located in the posterior segment of the eye.

Collins simply discloses "conjugates", but does not suggest the presently claimed compositions any more than the disclosure of a compound with, for example, a phenyl ring renders obvious all other compounds having a phenyl ring. Collins does not discuss compositions for treatment of the posterior segment of the eye at all.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the present rejections and permit the present application [to proceed to issue.

Applicants hereby authorize the Director to use Deposit Account 01-0885 for payment of the fee associated with filing the Request for Continued Examination, and for payment of a one-month's Extension of the Time to reply to the Examiner's Answer. If any other fee is due, Applicants hereby authorize the Commissioner to use Deposit Account 01-0885 for the payment of such fee.

Respectfully submitted,



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Appendix

1. Declaration Of Patrick Hughes Ph.D.